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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,330	04/07/2004	Gregg D. Scheller	54084-47038	8512
21888 7590 09/23/2009 THOMPSON COBURN LLP ONE US BANK PLAZA SUITE 3500 ST LOUIS, MO 63101				
EXAMINER				
DOWE, KATHERINE MARIE				
ART UNIT		PAPER NUMBER		
3734				
NOTIFICATION DATE		DELIVERY MODE		
09/23/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDOCKET@THOMPSONCOBURN.COM

# Office Action Summary

**Application No.**

10/820,330

**Applicant(s)**

SCHELLER ET AL.

**Examiner**

KATHERINE M. DOWE

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on June 15, 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-42, 47, 48, 51 and 52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-42, 47, 48, 51 and 52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date 6/15/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The following is a complete response to the amendment filed June 15, 2009.
2. Claims 25-42, 47, 48, 51, and 52 are currently pending. No claims have been amended.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 25-42, 47, 48, 51, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toth et al. (US 6,616,683) in view of Specht et al. (US 4,938,214). Toth et al. disclose the invention substantially as claimed including a microsurgical instrument comprising an elongate rod (14-1) having opposite proximal and distal ends. A slot (14-3) in the distal end of the rod forms a pair of resilient spring arms (14-2) projecting from the rod, with a pair of opposed, operative microsurgical surfaces on the spring arms. The pair of operative microsurgical surfaces may be interpreted as a pair of forcep jaws. The slot, the pair of spring arms, and the pair of operative microsurgical surfaces are formed by electric discharge machining in a single piece of material (col 3, ln 47-58; Figures 3A-3B). The Examiner notes the filler material may be omitted from the forcep jaws (col 4, ln 25-26; Figure 6) and thus the operative microsurgical surface (14") may be interpreted as being formed solely by electric discharge machining.

Regarding claims 36 and 51, the operative microsurgical surfaces may alternatively be interpreted as scissor blades. The Examiner notes the claims do not provide a structural difference between the forcep jaws and scissor blades.

However, Toth et al. do not disclose the operative microsurgical surfaces comprise serrations. Specht et al. disclose a similar microsurgical instrument (col 6, ln 32-47) with an elongate rod and resilient spring arms (312, 314) having operative microsurgical surfaces (312a, 314a). Specht et al. teach "in a preferred embodiment, the mating surfaces of the working area are provided with a series of serrations extending, with reference to FIG. 14, into the plane of the paper" (col 16, ln 67 – col 17, ln 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Toth et al. such that the operative microsurgical surfaces comprised serrations to improve the gripping function of the surfaces. Furthermore, it is obvious to make features of microsurgical instruments as small as possible such that the device is useful in a microsurgical environment. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the serrations such that the width between adjacent peaks of the serrations was within the range of 0.0015 to 0.0039 of an inch, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering optimum or workable ranges involves only routine skill in the art. See *In re Aller*, 105 USPQ 233.

Regarding claims 28, 48, and 52, the claimed phrases "the series of serrations being a wire electric discharge machined surface" and "the pair of forcep jaws/scissor

blades opposed serrated surfaces having been formed solely by electric discharge machining" are being interpreted as a product by process limitation; that is, the serrations are made by wire electric discharge machining. As set forth in MPEP 2113, product by process limitations are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C. 102/103 rejection may be made and the burden is shifted to the applicant to show an unobvious difference. See MPEP 2113. Alternatively, Toth et al. disclose the device is formed of wire electric discharge machining col 3, ln 47-58; Figures 3A-3B). Therefore, it would have been obvious to one of ordinary skill in the art to additionally form the series of serrations from wire electric discharge machining (EDM), as such a manufacturing method is well known in the art of microsurgical instruments.

### ***Response to Arguments***

5. Applicant's arguments filed June 15, 2009 have been fully considered but they are not persuasive.
6. Applicant argues the prior art is not capable of producing serrations smaller than 0.007 of an inch. Applicant additionally argues *In Re Aller* may not be applied since a range of serrations less than 0.007 of an inch is not a known range of serrations. Finally, Applicant argues claims 28, 48, and 52 are not product by process steps because serrations formed by EDM creates a structure distinct from the prior art serrated surfaces, since the prior art serrated surfaces are not capable of having

serrations smaller than 0.007 of an inch. Applicant has provided no evidence to establish an unobvious difference between the claimed product and the prior art, but rather has merely argued such alleged difference. Mere arguments can not take the place of evidence. *In re Walters*, 168 F.2d 79,80, 77 USPQ 609,610 (CCPA 1948); *In re Cole*, 326 F.2d. 769,773, 140 USPQ 230,233 (CCPA 1964); *In re Schulze*, 346 F.2d 600,602, 145 USPQ 716,718 (CCPA 1965); *In re Lindner*, 457 F.2d 506,508, 173 USPQ 356,358 (CCPA 1972); *In re Pearson*, 494 F.2d 1399,1405, 181 USPQ 641,646 (CCPA 1974); *Meitzner v. Mindick*, 549 F.2d 775,782, 193 USPQ 17,22 (CCPA), cert. Denied, 434 U.S. 854 (1977); *In re DeBlauwe*, 736 F.2d 699,705, 222 USPQ 191,196 (Fed. Cir. 1984).

7. Applicant argues Toth does not teach or suggest operative microsurgical surfaces formed solely by electric discharge machining. Applicant contends the filler material 14-4 provides the operative surgical surface of Toth. The Examiner respectfully disagrees with Applicant's remarks. As noted in the rejection, the filler material may be omitted from the forcep jaws (col 4, ln 25-26; Figure 6) and thus the inner surface of the forcep jaws, that would contact the filler material if such a material was provided, may be interpreted as the operative microsurgical surface (14"), wherein the forcep jaws are formed solely by electric discharge machining.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHERINE M. DOWE whose telephone number is (571)272-3201. The examiner can normally be reached on M-F 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Katherine Dowe  
September 9, 2009

/K. M. D./  
Examiner, Art Unit 3734

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3734